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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,217	11/09/2000	Martin Bergenwall	781.389USW1	6709
32294	7590	02/25/2004		
SQUIRE, SANDERS & DEMPSEY L.L.P. 14TH FLOOR 8000 TOWERS CRESCENT TYSONS CORNER, VA 22182			EXAMINER PIZARRO, RICARDO M	
			ART UNIT 2661	PAPER NUMBER 10

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/711,217

Applicant(s)

BERGENWALL ET AL.

Examiner

Ricardo M. Pizarro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 11, 12, 17, 21-28 and 37 is/are rejected.
- 7) ☒ Claim(s) 2-10, 13-16, 18-20 and 29-36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings.

Claim Objections

2. Claims 1-27, 35-37 are objected to because of the following informalities and it is suggested to applicant:

In claim 1 line 4 replace “the” with –an-, in line 5 replace the first occurrence of “the” with –a-, in line 9 replace the first occurrence of “the “ with –a-,

In claim 2 line 1 delete “the” , in line 2 delete the last occurrence of “the”, in line 4 replace “adaptation” with –transmitting-.

In claim 3 line 1 delete “the”, in line 2 delete the last occurrence of “the”, in line 3 replace “adaptation” with-transmitting-.

In claim 5 line 3 replace “adaptation” with –transmitting-.

In claim 8 line 2 replace “adaptation” with –transmitting-, in line 7 replace “the” with –a-.

In claim 9 replace “transmission” with -transmitting-, in line 5 replace “the” with –a-, in line 7 replace “the” with –a-, in line 12 replace the first occurrence of “the” with –a-.

In claim 12 in line 12 insert “the station” before –characterized-, lines 13 and 18 replace “are” with –is-; in line 13 delete “the”, in line 14 replace the first occurrence of “the” with –an-.

In claim 13 line 2 replace “are” with –is-.

In claim 14 line 2 replace “are” with –is-, in line 6 delete the first occurrence of “the”.

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In claim 15 line 2 replace “are” with –is-, in line 3 replace the second occurrence of “the “ with –a-.

In claim 16 line 2 replace “are” with –is-.

In claim 17 line 5 replace the second occurrence of “the” with –an-, in line 7 replace “the” with –a-.

In claim 18 lines 3 and 5 delete the first occurrence of “the”

In claim 19 line 6 delete the last occurrence of “the”.

In claim 20 line 2 replace “are” with –is-, line 3 replace the second occurrence of “the” with –a-.

In claim 22 in line 5 replace the second occurrence of “a” with –the-, in line 6 replace “a” with –the- in line 8 delete the first occurrence of “the” and replace the second occurrence of “the” with –an-, in line 9 replace “the” with –an-, in line 10 delete the first occurrence of “the”, in line 11 delete the first occurrence of “the” and replace the second occurrence of “the” with –a-.

In claim 23 line 7 delete the first occurrence of “the”, and replace the second occurrence of “the” with –an-, in line 9 delete the second occurrence of “the”, in line 11 replace “the” with –a-.

In claim 24 line 12 replace “are” with –is-, delete the first occurrence of “the” and replace the second occurrence with –an-, in line 15 replace “are” with –is-, in line 16 replace the second occurrence of “the” with –a-.

In claim 25 line 8 replace the first occurrence of “the” with –an-, in line 9 replace “the “ with –an-, in line 10 delete the first occurrence of “the”, in line 11 replace the second occurrence of “the” with –a-.

In claim 26 line 5 delete the first occurrence of “the” and replace the second occurrence of “the” with –an-, in line 6 delete the first occurrence of “the” and replace the second occurrence of

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“the” with –an-, in line 8 delete the first occurrence of “the”, in line 9 delete the second occurrence of “the”.

In claim 27 line 11 and 14 replace “are” with –is-, in line 11 replace the second occurrence of the” with –an-, in line 14 delete “the”, in line 15 replace the third occurrence of “the” with –a-.

In claim 35 line 3 delete “the”, in line 5 replace the third occurrence of “the” with –a-, in line 7 replace the first occurrence of “the” with –a-.

In claim 37 line 11 delete “said”

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. Claims 1, 11, 17, 21, 22, 23, 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Widegreen.

US patent no. 6,374,112 (Widegreen) discloses a flexible radio access and resource allocation in a universal mobile telephone system disclosing a handover method between two radio systems with different physical traffic channels (col 3 lines 55-58, different radio channels Fig. 7) and different radio link protocol comprising retransmission mechanism (RLP protocols, col 7 lines 21-22), the method comprising handing over a non-transparent call from a radio channel from a traffic channel of an old radio system to a traffic channel of a new radio system (col 7 lines 18-36), retaining the radio link protocol of the old radio system between a mobile station and an interworking function (MS 30 in Fig. 3 and interworking function, col 8 lines 9-15), transmitting radio link frames of the old radio system adapted to the traffic channel of the new radio station (by the IWF adapting GSM to UMTS and performing mapping, col 8 lines 9-14), as in claims 1, 11, 22, 23, 25; the new and old radio system are separate systems (radio systems are different i.e. col 8 lines 51-54), as in claims 17, 21.

5. Claims 12, 24, 26, 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Widegreen

A dual-mobile station (MS 30 in Fig. 3) with capacity to operate between two radio systems (col 3 lines 55-58, different radio channels Fig. 7) with different physical traffic channels and different radio link protocols (RLP protocol, col 7 lines 21-22) comprising adapter means for establishing a first radio link protocol in a non-transparent call between the MS and an interworking function (interface mapping col 8 lines 9-15), first radio system and second radio link protocol between the mobile station and the interworking function in a second radio system

(RLP protocols, col 7 lines 21-22), means for performing a handover for the non-transparent call from a traffic channel of the first radio system to a traffic channel of the second radio system and viceversa (col 7 lines 18-36), the system characterized in that said adapter is arranged to retain radio link protocol of an old radio system between the mobile station and the interworking function in a handover that is carried out from the traffic channels of the first radio system to the traffic channel of the second radio system or viceversa (MS 30 in Fig. 3 and interworking function, col 8 lines 9-15), said adapter means is arranged to transmit the radio link protocol frames of the old radio system adapted to the traffic channel of the new radio system .(by the IWF adapting GSM to UMTS and performing mapping, col 8 lines 9-14), as in claim 12, 24, 26, 27.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 28, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sallberg in view of Willars.

Claims 28 and 37 are rejected under 35 U.S.C. 103(a) as being anticipated by Sallberg.

US patent no. 6,073,018 (Sallberg) discloses a system and method for interworking of wireless communication systems with ISDN network, comprising a mobile communication system

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comprising a mobile services switching center (MSCC 12 in Fig. 2) with a first link protocol provided with a retransmission mechanism for non-transparent data transmission (different protocols), a radio access network with a second link protocol provided with a retransmission mechanism (RLP protocol, see Fig. 3) for non-transparent data transmission and an interworking unit via which the radio access network is connected to the MSC said unit is arranged to adapt the first link protocol to the radio access network such that the retransmission of data is controlled from end to end between the MSCC and the MS (TE 14 in Fig. 3 and MSCC 32 in Fig. 3), as in claims 28 and 37.

Sallberg did not specifically disclose frame numbering in the retransmission mechanism, as in claims 28 and 37.

US patent no. 6,480,476 (Willars) discloses an adaptive mobile system (2G-3G) that makes use of frame numbering in the retransmission mechanism (col 1 lines 16-23, col 7 lines 29-47), as in claims 28 and 37.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to provide the frame numbering system to the interworking mechanism disclosed by Sallberg with the motivation of obtaining a radio access system that provides wireless access at very high rates and supports enhanced bearer services with different generation mobile systems.

Allowable Subject Matter

8. Claims 2-10, 13-16, 18-20, 29-36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the

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limitations of the base claim and any intervening claim. Please also notice objection to claim
sunder 37 CFR 1.75

Conclusion

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314

(for formal communications intended for entry, for informal or draft communications, please
label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner
should be directed to **Ricardo Pizarro** whose telephone number is (703) 305-1121. The
examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM. The fax
number for this Group is (703) 872-9314.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, **Douglas Olms**, can be reached on (703) 305-4703.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

February 20, 2004

Ricardo M. Pizarro



DOUGLAS OLMS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600